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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,383	02/02/2000	Phuong V. Luu	1775-1A	6132

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/06/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary

Application No. 09/496,383	Applicant(s) LUU ET AL.	
Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 26-31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 26-31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. ***Claim 34 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as per reasons set forth in the previous Office Action per paper no. 11, 06/03/02, paragraph no. 3.***

Claim Rejections - 35 USC § 103

3. ***The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:***

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. ***The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:***

- 1. Determining the scope and contents of the prior art.***
- 2. Ascertaining the differences between the prior art and the claims at issue.***
- 3. Resolving the level of ordinary skill in the pertinent art.***
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.***

5. ***This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was***

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. *Claims 1-3, 26, 29-31, 34 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg et al as per reasons stated in the previous Office action per paper no. 11, 06/03/02. Further, properties such as "releasable" and "sprayable" governing the creping adhesive of Hollenberg et al are taught at least in col. 1, lines 28-37 & 51-59, col. 3, lines 1-9 and col. 4, lines 27-40. See claims 1 and 35, as claimed.*

Claim Rejections - 35 USC § 103

7. *Claims 1-5, 26-31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aston et al(U.S. 5,246,548) in combination with Greer et al(U.S. 5,230,774).*

Aston et al disclose and exemplify processes for controlling and/or preventing pitch deposits on papermaking machine dryer fabrics or equipment surfaces which comprise separately or simultaneously applying to the fabrics or equipment surfaces by a spraying technique, a water-soluble or water-dispersible cationic polymer having a molecular weight between 1,000 and 500,000 and inclusive of polyamine polymers, a water-soluble or water dispersible anionic aromatic polymer and optionally, wetting agents. More specifically, Aston et al exemplify the application of a cationic polymer(epiamine polymer)/anionic aromatic polymer combination to paper machine dryer fabrics wherein the cationic polymer, viz. the epiamine polymer and the anionic polymer are sprayed from two separate atomizing nozzles onto a dryer fabric of a paper machine dryer(Run 1).

The disclosure of Aston et al, viz., Run 1, differs basically from the claimed invention as per the absence of a zirconium x-linking agent in the compositional formulation. However, Greer et al disclose the use of zirconium compound, cross linked cationic polymers in controlling and/or preventing pitch in pulping and paper-making processes similar to those of Aston et al. Therefore, one having ordinary skill in the art would have found it obvious, on its face, to use the cross linked cationic polymers in the system of Aston et al and with a reasonable expectation of

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enhancing the pitch control and/or prevention. See the Abstract, cols. 1-3, 5, 6 and the claims of Aston et al and the Abstract, cols. 1-6, the Runs and the claims of Greer et al. If not taught, it is tenable that the composition of Aston et al(modified) is releasable since the modified composition of Ashton is essentially the same as the claimed adhesive composition.

The interchangeability of one well known cationic polymer for another is a matter of ordinary choice to the skilled artisan and with a reasonable expectation of success.

As to the dependent claims, the limitations are either taught by patentee(s), suggested by patentee(s) or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Response to Amendment

8. After further consideration coupled with the amendments to the claims/Counsel's persuasive arguments, the rejections based on Kotaini('560 & '029) & Smigo et al are herein withdrawn.

Response to Arguments

9. Applicant's arguments filed 10/09/02 have been fully considered but they are not persuasive.

Relative to Hollenberg et al—Counsel argues a) combining the components in such a manner that would provide a releasable and sprayable adhesive is not disclosed; b) the compositional components of Hollenberg are not the same as the claimed compositional components; c) the manner in which the components are combined, i.e., mixing the components prior to contacting them on a Yankee dryer or similar heating source, would not and could not produce the components of the present invention.

The crux of Counsel's arguments appears to hinge on only those mixing parameters disclosed in the present specification would yield a composition that is both sprayable and releasable and is relying on the Declaration of Inventor Van Luu(02/02/00) in support of such. To this end, Counsel is herein reminded that a composition and not a method is

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being claimed. Further, the Declaration of Inventor Van Luu is one of opinion from an interested party and is of little probative value especially since the compositions of Hollenberg et al are taught as both being sprayable and releasable.

It is urged and maintained that the "polysaccharides" of Hollenberg et al are generic to and necessarily imply that any organic polymer, including the claimed organic polymers having in the backbone amine groups such as chitosan, would have been operable within the scope of patentees invention and with a reasonable expectation of success. There is no evidence on this record establishing otherwise. Consult In re Woodruff(16 USPQ2d 1934(Fed. Cir. 1990)).

Relative to the 112, 2nd paragraph issue---It is urged and maintained that it is not readily ascertainable as to how the limitations of claim 34 further limit the "adhesive composition" of claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
December 30, 2002